

### **REMARKS**

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

#### ***Status of the Claims***

Upon entry of the present amendment, claims 1-4 and 6-11 will be pending in the present application. Claim 5 has been cancelled herein. Claims 1, 6-7 and 9 have been amended. Support for the recitations in claims 1 and 9 can be found in claim 5 as originally filed and in the specification, *inter alia*, at page 6, lines 8-13. Claims 6-7 have been amended for clarification purposes. In addition, support for the recitations of claim 6 can be found, *inter alia*, at page 5, line 24-29, and support for the recitations of claim 7 can be found in the specification, *inter alia*, at page 5, lines 17-21. No new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

#### ***Earlier Filed IDS***

The Examiner stated that the lined references were not considered since Applicant failed to provide, for each non-English foreign patent, a concise explanation of relevance.

With respect to JP 8-24289 A and JP 60-199962, Applicant's Representative noted to the Examiner in a telephonic interview on April 7, 2008, that translations of both references were properly submitted. The Examiner indicated that the translations were overlooked.

Regarding JP 11-61617 A, Applicant provided an English translation of a Chinese Office Action citing the reference. The English translation of the Chinese Office Action is acceptable as a concise explanation of the reference. (See MPEP 609.04(a)(III)).

In view of the above, the Examiner is requested to return a copy of Form PTO/SB/08 indicating that these three references were considered.

***Issues under 35 U.S.C. § 112, second paragraph***

The Examiner has rejected claims 5-7 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that the term “interfiber distance” in claims 5-6 is vague and indefinite. In addition, the Examiner alleges that the phrase “localized in the side with no cotton fiber layer” of claim 7 is vague and indefinite.

Applicant has replaced the term “interfiber distance” in claim 6 with “distance between fibers.” The same terminology can be found in claims 1 and 9, which incorporate the subject matter of cancelled claim 5. With respect to claim 7, Applicant has amended the claim to recite “localized in the side of said nonwoven fabric with no cotton fiber layer.” Applicant respectfully submits that these amendments overcome the outstanding rejections and that the rejections be removed.

***Issues under 35 U.S.C. § 102(b)***

The Examiner has rejected claims 1-3, 8 and 11 under 35 U.S.C. § 102(b) as being anticipated by Welchel ‘818 (US 6,022,818) alone or optionally taken with Taneichi ‘481 (US 6,844,481). Applicant respectfully asserts that Welchel ‘818 and Taneichi ‘481 do not disclose each and every element of independent claim 1. Therefore, Welchel ‘818 optionally taken with Taneichi ‘481 do not anticipate nor render obvious claim 1.

As amended, independent claim 1 recites, *inter alia*, that “the distance between fibers gradually decreases from the side with the cotton fiber layer being presented to the center of the thickness of the fibrous sheet.” This element of claim 1 incorporates the subject matter of claim 5, which the Examiner indicated was allowable.

As such, claim 1, and those claims dependent thereon, are not anticipated by nor rendered obvious over Welchel ‘818 optionally taken with Taneichi ‘481. Withdrawal of the rejection is respectfully requested.

***Issues under 35 U.S.C. § 103(a)***

1) The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Welchel ‘818 taken with Pike ‘045 (US 6,169,045).

2) The Examiner has rejected claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Welch '818 alone or taken with Taneichi '481.

Applicant respectfully traverses, and reconsideration and withdrawal of these rejections are respectfully requested.

Legal Standard for Determining Prima Facie Obviousness

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

*Graham v. John Deere*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court

recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

#### Distinctions Over the Cited Art

As discussed above, Welchel '818 do not disclose each and every aspect of claim 1, from which claim 4 depends. Applicant respectfully submits that Pike '045 does not overcome the deficiencies of this reference. As stated above, independent claim 1 contains the subject matter of claim 5, which the Examiner has indicated is allowable. As such, Applicant respectfully submits that this rejection has been overcome.

As amended, independent claim 9 recites, *inter alia*, that "the distance between fibers gradually decreases from the side with the cotton fiber layer being presented to the center of the thickness of the fibrous sheet." This element of claim 9 incorporates the subject matter of claim 5, which the Examiner indicated was allowable. As such, Applicant respectfully submits that this rejection has been overcome since claim 9, and those claims dependent thereon, clearly distinguish over the cited prior art.

To establish a *prima facie* case of obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. (See MPEP 2143.03). As discussed above, the combination of references fails to teach or suggest all the claims limitations of independent claims 1 and 9, and those dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the instant rejection is respectfully requested.

***Allowable Subject Matter***

Applicant acknowledges the indication of allowable subject matter of claims 5-7 if rewritten or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicant has incorporated the subject matter of claim 5 into independent claims 1 and 9. For the reasons indicated above, all pending claims are believed to be directed to allowable subject matter.

**CONCLUSION**

A full and complete response has been made to all issues as cited in the Office Action. Applicant has taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicant respectfully requests that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1-4 and 6-11 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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